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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/359,359      | 07/23/1999  | KRZYSZTOF MATYJASZEWSKI | 5344-0017-23        | 2715             |

7590 06/27/2002

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EXAMINER

PASTERCZYK, JAMES W

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1755

17

DATE MAILED: 06/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

MF-17

# Office Action Summary

Application No.

09/359,359

Applicant(s)

Matyjaszewski et al.

Examiner

J. Pasterczyk

Art Unit

1755



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 18, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 70, 71, 74, and 81-124 is/are pending in the application.
- 4a) Of the above, claim(s) 81-116 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 70, 71, 74, and 117-124 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 70, 71, 74, and 81-124 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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1. This Office action is in response to the amendment filed 4/18/02 and refers to the rejection mailed 10/18/01.

2. The abstract of the disclosure is objected to because it still speaks in functional terms of what the initiator may do rather than what it is in the sense of what functional groups it contains. Correction is required. See MPEP § 608.01(b).

3. Due to the previous restriction and election, claims 81-116 will still be treated as withdrawn, and claims 70, 71, 74 and new claims 117-124 will be treated as actively under consideration in this case.

4. Claims 70, 71, 74 and 117-124 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are not commensurate in scope with the enabling disclosure because the claims are excessively broad since they use functional language to describe what the initiators are capable of doing rather than what functional groups they contain. In addition, there appears to be no disclosure of how to use the initiator species elected, although examples 270-271 disclose how to make it.

5. Claims 70, 71, 74 and 117-124 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 70, 71 and 74 now depend from cancelled claims, hence their scope is completely unclear. These claim should have been cancelled along with those cancelled in the immediately previous amendment. ✓

Claims 117-124 fail to define the metes and bounds of the invention because they still recite the invention in functional language. Reciting a group by what it may do rather than what it is is functional claiming. For example, in claim 117, "at least one radically transferable atom or group capable of initiating an atom transfer radical polymerization" only says that an atom or group is on the molecule, plus what it may do, the latter being so dominant of the language that it renders the entire clause vague and indefinite in that what functional groups may be capable of this function are not recited at all. Although applicants point to the specification for guidance as to what these groups may be, it is impermissible to import limitations from the specification into the claims, as this argument by applicants does. In a further example of functional language, in claim 119 "derived from" tells the reader only what the functional group was made from in some unknown, unspecified number of steps in a supposedly organic chemical transformation way far away in the past, not what the functional group actually is now as it is being claimed. The metes and bounds of such a claim can simply not be discerned so as to put other inventors on notice of what the invention actually is. Such phrases as "capable of initiating", "derived from", "capable of being" etc. all signal functional language. Since the claims are recited in functional language, they are also omnibus. ✓

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6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 70, 71, 74 and 117-124 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MacLeay as cited in and for the reasons of record given in paragraph 7 of the previous Office action.

Given the broad, functional claiming of new claims 117-124 and the fact that the molecules already pointed out in MacLeay have two functional groups which appear to satisfy the requirements of this functional language, the rejection is not considered overcome.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 703-308-3497. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310 for normal communications, 872-9311 for after final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Mark L. Bell  
Supervisory Patent Examiner  
Technology Center 1700



J. Pasterczyk

6/20/02